

REMARKS

Claims 57-74 are pending. Claim 67 has been amended. No new matter has been added.

Claim Rejections - 35 U.S.C. § 112, second paragraph

Claim 67 has been rejected as indefinite. Applicants have amended claim 67 to specify that the recited chimeric polypeptide comprises at least one chemokine polypeptide covalently attached to at least one heterologous polypeptide, wherein the heterologous polypeptide is an Fc polypeptide and the chemokine polypeptide comprises SEQ ID NO:1 from amino acid 22 to amino acid 328. It is believed this amendment obviates the rejection.

Rejections for Obviousness-Type Double-Patenting

Claims 57-74 have been rejected for nonstatutory obviousness-type double-patenting in view of claims 1-17 of U.S. Pat. No. 6,730,296 ("the '296 patent"). The rejection is traversed.

The claims subject to the rejection require an Fc polypeptide. Applicants argued in their previous response that the Fc polypeptide required by the present claims is not disclosed in the claims of the '296 patent, and that there is no suggestion of an Fc polypeptide, or a polypeptide with the features of the Fc polypeptide, in the claims of the '296 patent.

In maintaining the rejection the Examiner asserts that the specification defines a heterologous polypeptide as an Fc polypeptide (see page 4, first full paragraph, last sentence). This is incorrect. While the Applicants do not dispute that the specification can be used as a dictionary to learn the meaning of a term in patent claim, the portions of the specification relied on by the Examiner do not state that an Fc polypeptide is synonymous with a heterologous polypeptide. Instead, the specification teaches that an Fc polypeptide is a preferred type of heterologous polypeptide: Column 2, lines 59-60 and column 6, lines 24-25 state that

“[p]referably, the heterologous polypeptide is an Fc polypeptide.” The specification does not, however, define a heterologous polypeptide to be an Fc polypeptide.

As a preferred polypeptide, an Fc polypeptide can be considered as a species of the genus heterologous polypeptide. In this sense the claims of the ‘296 patent in reciting a heterologous polypeptide dominate the instant claims in reciting an Fc polypeptide. This does not without more constitute double-patenting. MPEP § 804 states:

Domination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 USPQ 474, 482 (CCPA 1964). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Other than incorrectly asserting that the Applicants define a heterologous polypeptide as an Fc polypeptide, the Examiner has provided no basis supporting the double-patenting rejection. In view of the foregoing comments, Applicants request reconsideration and withdrawal of the rejection for obviousness-type double patenting.

Applicants submit that the application is in condition for allowance, and request an allowance for same. A petition for extension of time and Notice of Appeal accompany this response. The Commissioner is authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 22058-590 DIVCON.

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